

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated October 11, 2006. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-18 are pending in the Application. Claims 1, 7 and 15 are independent claims. Claims 17-20 are newly added claims. Claims 1, 15 and 16 are amended herein to cure obvious clerical errors noted upon review of the claims and was not provided for the purpose of patentability. Accordingly, it is respectfully submitted that claims 1, 15 and 16 are entitled to a full range of equivalents under the doctrine of equivalents.

In review of the present Office Action, it appears that there is confusion as to what required by the currently pending claims. Claim 1 for example which requires "wherein the data carrier is configured to simulate access to the external network" is nowhere addressed in the present Office Action. Nor are similar elements of claims 3, 7 and 15 addressed in the present Office Action. As pointed out in the previously submitted amendment, the claims in the previous amendment were amended to clarify what was intended,

yet these portions of the claims are not addressed in the current Office Action.

In the current Office Action, Claims 1-4, 6-11 and 13-16 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Japanese Patent Publication No. JP 06-118914 to Katsutoshi ("Katsutoshi"). Claims 5 and 12 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Katsutoshi in view of U.S. Patent No. 6,020,886 to Jacober ("Jacob"). It is respectfully submitted that claims 1-20 are patentable for at least the following reasons.

Katsutoshi shows a system to provide an automatic demonstration device which eliminates the need for a program dedicated to demonstration. A program which provides the original function of the device is stored in the ROM 12 and reference data and demonstration data are stored on the external medium 19 (see, Katsutoshi, FIGs. 1 and 2 and the abstract).

However, it is respectfully submitted that there is no showing or suggestion in Katsutoshi of an inherent function including use of an external data network as required by the present claims. Additionally, there is no showing or suggestion of a data carrier configured to simulate access to the external data network

regardless of whether the external data network is currently available as required by claim 1 and as similarly required by each of the currently pending claims.

The Office Action on page 2, lines 5-8 states that claim 1 reads on (emphasis added) "just data having the demo data of the device. Therfor, if the device has a network capability, then the demo data on the disk would include and show such inherent capability. Thus data per se on a disk does not carry any patentable weight since any data could be recorded on a medium."

The Applicant respectfully disagrees.

First, the device in Katsutoshi nowhere discloses or suggests a network capability, and therefore the section of the Office Action on page 2, lines 6-7 stating "if the device has a network capability, the demo data on the disk would include and show such inherent capability" is not supported by Katsutoshi in that such an inherent capability is neither disclosed nor suggested therein. In fact, nowhere within the four corners of Katsutoshi is there a hint or suggestion that a network capability may be an inherent feature. Accordingly, the Applicant respectfully disagrees with the position forwarded in the Office Action. Moreover, the MPEP §2131 provides that a claim is anticipated only if each and every element as set

forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. Accordingly, Applicant respectfully submits that the Office Action fails to make a prima facie case of anticipation since the claims of the present application require elements that are neither disclosed nor suggested expressly or inherently by Katsutoshi. Apparently this is recognized by the Office Action in that the Office Action clearly stipulates that "if the device has network capability ..." (see, the Office Action, page 2, lines 6-7) which certainly recognizes that there is no expressed or inherent disclosure of this feature by Katsutoshi.

Additionally, in response to the inherency argument in the Office Action, Appellant respectfully notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art. Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The MPEP

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v.

echoes this case law stating "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (See, MPEP §2112, emphasis in original, citations omitted.)

Further, the following is also pointed out that "[i]n relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art. (See, MPEP §2112, emphasis in original, citations omitted.)

It is well established that a recited element is inherently present in a prior art reference only if that element is necessarily present in that reference, and further that its presence would be recognized by one of ordinary skill in the art from what has been expressly described. The Office Action must

Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added): "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oerlich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgirg v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: 'Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" This citation is also set out in MPEP. § 2131.01(d).

provide objective evidence or cogent technical reasoning to support the contention that this element is present in Katsutoshi.

However, it must also be pointed out that the claims as presented also require more than an inherent feature including use of an external data network as described in more detail below.

Second, claim 1 of the present application requires more than mere "data...on a disk". The Office Action seems to suggest that claim 1 merely requires data, such as music or video files, be contained on a disk. It is respectfully submitted that the claims as provided require substantially more than mere data on a disk. Claim 1 as provided requires simulating access to an external network which is simply not disclosed or suggested in Katsutoshi.

The Office Action states on page 4, lines 13-16 that the claims of the present application are "merely interpreted as data recorded on the disk having the inherent demo data of the device where the device is an optical head within a computer having an external network capability or not. the reference JP '914' is drawn to the use of an external network 11 and 12 with respect to an external medium 19." The Applicant respectfully disagrees.

As stated previously, Katsutoshi (JP '914) does not disclose or suggest an external network. Second, even if in arguendo

Katsutoshi shows or suggests an external network (a position which is strenuously opposed as should be clear from the discussion above), the reference still fails because it does not disclose or suggest a data carrier configured to simulate access to the external network regardless of whether the external data network is currently available, as for example required by claim 1.

In stark contrast to Katsutoshi, claim 1 of the present system requires, and claims 7 and 15 also similarly require, amongst other patentable elements, (illustrative emphasis provided), "[a] data carrier comprising demonstration control data configured to control a demonstration of an inherent function of a playback device wherein the inherent function includes use of an external data network wherein the data carrier is configured to simulate access to the external network regardless of whether the external data network is currently available." Jacober is cited for other reasons which do not cure the defects in Katsutoshi.

The claims accordingly require at least an inherent function of a playback device that includes use of an external data network. Further, the claims, such as for example Claim 1, require that (illustrative emphasis added) "the data carrier is configured to simulate access to the external network ..."

Based on the foregoing, the Applicant respectfully submits that independent Claims 1, 7 and 15 are patentable over Katsutoshi and notice to this effect is earnestly solicited. Claims 2-6, 8-14 and 16-20 each depend from one of Claims 1, 7 and 15 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of said claims.

For example, Katsutoshi, Jacober, and any combination thereof do not disclose or suggest a data carrier "further configured to simulate access to the external data network by simulating a connecting process over a network interface to the external data network" as required by claims 17 and 19; nor a data carrier "further configured to simulate a waiting time for access to network services" as required by claims 18 and 20. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

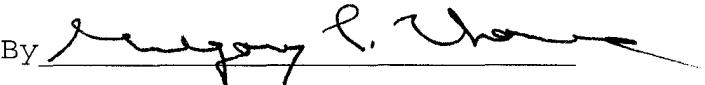
In addition, Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicant reserves the right to

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submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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